

REMARKS

I. Introduction

Claims 1,14-24 and 26-65 are pending in the present application. Claims 1, 14, 15, 19, 20, 26, 27, 29, 30, 33, 34, 41, 45, and 49 have been amended to clarify the subject matter recited therein and correct various informalities. Claim 25 has been cancelled. No surrender of claim scope is intended by the present amendments. New claims 50-65 have been added. Applicants respectfully submit that the new claims are supported by the originally filed specification. Applicants believe that no new search is necessary, and that no new matter has been added. Reconsideration of the present application is respectfully requested in light of the amendments and the following remarks.

II. Telephone Interview

Applicants thank Examiner for the courtesies extended during the course of the telephone interview with Applicants' representative on December 19, 2003.

During the course of the interview, proposed new claims and the references cited in Examiner's Office Action of September 8, 2003 were discussed. It is believed that in light of the interview and the discussions below, that there are no remaining objections or rejections to the claims.

III. Rejection of Claim 41 Under 35 U.S.C. § 112

Claim 41 stands rejected under 35 U.S.C. § 112 second paragraph for allegedly being indefinite. Claim 41 has been amended to correct the typographical error and to correctly indicate that claim 41 depends from claim

40. No change in claim scope is intended in light of this amendment.

Applicants respectfully submit that this rejection is moot in light of this amendment.

IV. Rejection of Claims 26-32 Under 35 U.S.C. § 102(b)

Claims 26-32 stand rejected under 35 U.S.C. § 102(b) as anticipated by Quinlan. It is respectfully submitted that Quinlan does not anticipate claims 26-32 for at least the following reasons.

Amended Claim 26 recites:

26. (Amended) A lottery game, the game being played by a plurality of participants, the game comprising:
a plurality of lottery tickets

. . . .
a first drawing event designation, wherein the first drawing event designation designates a subset of the plurality of panels to be played;

a random selection device external to the lottery ticket, wherein said random selection device selects a plurality of winning game pieces after the participant has received the lottery ticket.

Quinlan does not teach or suggest a first drawing event designation, wherein the first drawing event designation designates a subset of the plurality of panels to be played. To anticipate a claim, each and every element as set forth in the claim must be found in a single reference. See, Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631 (Fed. Cir. 1987). Quinlan generally discloses a game where the contestants choose which break open windows to open. Quinlan Col. 4:61-65. Quinlan does not teach or suggest a first drawing event designation designating a subset of panels to be played. Therefore Quinlan does not anticipate claim 26.

Moreover, Quinlan does not teach or suggest a random selection device external to the lottery ticket wherein the random selection device selects a plurality of winning game pieces after the participant has received the game ticket as recited in claim 26. Quinlan generally discloses a seal card where the winner indicia is pre-printed on the card and therefore pre-determined before the player receives the card. See Quinlan Col. 4:27-33. Quinlan does not teach or suggest a random selection device external to the lottery ticket where the winning game pieces are selected after the participant has received the lottery ticket. Therefore, Quinlan can not anticipate claim 26.

Further, Applicants respectfully suggest that Examiner's characterization of Quinlan shows that the claim language recited in claim 26 is not anticipated. Examiner stated that the seal card in Quinlan "contains a random outcome that selects a game piece." (emphasis added). The game recited in claim 26 recites a random selection device external to the game ticket. Therefore, Applicants respectfully assert that Quinlan does not anticipate claim 26.

Independent of the above, claims 27-32 depend directly or indirectly from claim 26. Therefore, Applicants submit that these claims are patentable over Quinlan for at least the reasons given above for claim 26.

Moreover, Applicants respectfully assert that Quinlan does not anticipate claim 32. Claim 32 recites a lottery ticket is a winning lottery ticket if a combination of winning game pieces matches at least one combination of revealed playing game pieces in the plurality of panels so that at least three of the revealed playing game pieces adjoin horizontally, vertically or diagonally to form at least one line. Quinlan generally discloses a game where the prize

area has pre-printed prize amounts that a player can choose from. Quinlan Col. 4:40-46. Thus, Quinlan does not teach or suggest matching winning game pieces with revealed playing game pieces. Further, because Quinlan discloses pre-printed prize amounts, Quinlan does not teach or suggest at least one line formed by the matching revealed game pieces. Therefore, Quinlan can not anticipate claim 32.

V. Rejection of Claim 45 Under 35 U.S.C. § 102(b) Over Roberts

Claim 45 stands rejected under 35 U.S.C. § 102(b) over Roberts.

Applicants respectfully traverse the rejection, and assert that claim 45 is not anticipated for at least the following reasons.

Claim 45 recites:

45. (Currently Amended) The method for playing a game as recited in claim 34, the method further comprising:

receiving instructions for using the game ticket in conjunction with at least two types of lottery-type drawing events, wherein the instructions are disposed on the ticket . . .

. . . .

indicating a playing life of the game ticket, wherein the playing life includes a range of lottery-type drawing event dates where the game ticket may be played; and providing a means for authenticating the game ticket.

As an initial matter, claim 45 depends from claim 34, therefore claim 45 should be patentable for at least the same reasons as claim 34 listed below.

Further, Applicants respectfully submit that Roberts does not anticipate claim 45. Roberts does not teach or suggest receiving instructions for using the game ticket in conjunction with at least two types of lottery-type drawing events. To anticipate a claim, a reference must contain each and every element of that claim. Figs. 2A-2C in Roberts discloses a lottery ticket printed

with " See Ticket Reverse for Complete Five Play Lotto Information." Roberts does not teach or suggest instructions for at least two types of lottery-type drawing events, therefore, Applicants respectfully submit that Roberts can not anticipate claim 45.

Moreover, Roberts does not teach or suggest indicating a playing life of the game ticket, wherein the playing life includes a range of lottery-type drawing event dates where the game ticket may be played. Roberts generally discloses a ticket that is tied to one specific drawing date printed on the ticket. In Roberts, once the specified drawing date has past, there are no further drawings that will allow play on the ticket. Roberts does not teach or suggest indicating a playing life of the game ticket wherein a player can choose which lottery-type drawing event to play in a range of lottery-type drawing events. Therefore, Applicants respectfully submit that Roberts does not anticipate claim 45.

VI. Rejection of Claim 1 Under 35 U.S.C. § 103(a) Over Quinlan in View of Roberts

Claim 1 stands rejected under 35 U.S.C. § 103(a) over Quinlan in view of Roberts. It is respectfully submitted that neither Quinlan nor Roberts render claim 1 obvious for at least the following reasons.

The Examiner has the burden of establishing a *prima facie* case of obviousness. See M.P.E.P. § 2142. Without a *prima facie* showing of obviousness, an applicant does not have an obligation to submit evidence of refuting obviousness. In order to establish a *prima facie* claim of obviousness, "all of the claim limitations must be taught or suggested by the prior art." M.P.E.P § 2143.03. Applicants respectfully submit that Examiner's

proposed modification of Quinlan with Roberts does not teach or suggest all of claim 1's recitations.

Claim 1 recites:

(Currently Amended) A universal lottery ticket, which can be used to participate in any one of a plurality of lottery-type drawing events, the ticket comprising:

- a substrate. . .
- a removable material having a surface . . .
- instructions for using the lottery ticket in conjunction with at least two types of drawing events, wherein the instructions for each type of drawing event are disposed on the ticket;
- a playing life of the lottery ticket, wherein the playing life includes a plurality of drawing events where the lottery ticket can be played.

Examiner states that Roberts discloses the instructions recited in claim

1. Applicants respectfully traverse Examiner's assumption. Claim 1 recites instructions for using the lottery ticket in conjunction with at least two types of drawing events. For example, in the instant application, one of the embodiments provides instruction for three types of drawing events: lotto, horse racing, and basketball. Roberts only describes information for one type of future drawing game, and therefore, does not teach or suggest instructions for using the lottery ticket in conjunction with at least two types of drawing events.

Moreover, Roberts does not teach or suggest a playing life of the lottery ticket. Examiner states that "*Roberts* discloses a system for providing lottery tickets allowing players to purchase a ticket for play at a later time for participation in a plurality of drawing events." Applicants respectfully traverse this characterization. Roberts discloses a ticket tied to the particular drawing event printed on the ticket, and not for "a plurality of drawing events" as Examiner suggests. Roberts, Fig. 2A. Since the ticket in Roberts is tied to

one printed drawing, Roberts can not teach or suggest playing life of the lottery ticket, wherein the playing life includes a plurality of drawing events where the lottery ticket can be played. Therefore, since Examiner's proposed combination does not teach or suggest all the claim limitations, Applicants respectfully submit that claim 1 can not be obvious over Quinlan in view of Roberts.

Moreover, a *prima facie* claim of obviousness also requires some suggestion or motivation in the art to modify or combine the references. See M.P.E.P. 2143. Applicants respectfully submit that Examiner has not provided a proper motivation in the prior art to modify the references. On pages 4 and 5 of the Office Action, Examiner states that Roberts provides the motivation to modify the references by suggesting "the modification [instructions and a playing life] enhance a game ticket by informing them of the lottery rules and by allowing players to purchase a ticket for play at later time and thereby increase revenues by allowing a greater number of players to participate by purchasing tickets at their convenience. See *fig. 2A; col. 2:1-8, 2:33-39.*" Applicants respectfully submit that the suggestion to modify is not present in Roberts as characterized by Examiner. Roberts discloses "providing a lottery ticket having a blank region adapted for having printing thereon information necessary to complete the ticket" and printing a ticket " with additional information necessary for the purchaser to instantly determine the win/lose outcome of the purchased ticket." Roberts Col. 2:4-8; Col. 2:36-39. Applicants respectfully suggest that Roberts does not disclose a suggestion to modify the references as Examiner proposes, therefore claim 1 can not be obvious over Quinlan in light of Roberts.

VII. Rejection of Claims 14-24 and 33 Under 35 U.S.C. §103(a) over Quinlan in view of Kamille

Claims 14-24 and 33 stand rejected under 35 U.S.C. § 103(a) over Quinlan in view of Kamille. Applicants respectfully traverse the rejections.

Claim 14 recites:

14. A method of playing a lottery game, the game being played by a plurality of participants, each participant having at least one lottery ticket the method comprising:
- receiving a lottery ticket comprising a plurality of concealed playing game pieces disposed in at least one array comprising a plurality of panels;
 - receiving a first drawing designation that designates some but not all of the plurality of panels as a playing panel for the game;
 - revealing a plurality of playing game pieces disposed on the lottery ticket, wherein said plurality of playing game pieces includes those concealed playing game pieces that are disposed beneath the designated plurality of panels;
 - after receiving the lottery ticket, receiving a first random selection of a plurality of winning game pieces, wherein the first random selection of the plurality of winning game pieces is external to the lottery ticket; and
 - determining whether the lottery ticket is a winning lottery ticket.

Quinlan and Kamille do not teach or suggest having a first drawing designation that designates some but not all of the plurality of panels as a playing panel for each game. As stated above, Quinlan generally discloses a game where the contestants choose which break open windows to open. Quinlan Col. 4:61-65. Kamille does not teach or suggest having a first drawing designation that designates some but not all of the plurality of panels as a playing panel for each game either. Kamille describes a probability game where play areas are revealed through player made choices, not

drawing designations. Kamille Col. 3:59-67. Therefore Quinlan and Kamille do not render claim 14 obvious either alone or in combination.

Independent of the above, neither Quinlan nor Kamille, alone or in combination teach or suggest after receiving the lottery ticket, receiving a first random selection of a plurality of winning game pieces, wherein the first random selection of the plurality of winning game pieces is external to the lottery ticket. As stated above in the anticipation argument, Quinlan does not teach or suggest after receiving the lottery ticket, receiving a first random selection of a plurality of winning game pieces, wherein the first random selection of the plurality of winning game pieces is external to the lottery ticket. Kamille does not teach or suggest a first random selection after receiving the lottery ticket recited in claim 14 either. Kamille generally describes a game ticket where the winning selections are pre-printed on the ticket before reaching the player, not after as the claim recites. Kamille Col. 6:25-32. Applicants respectfully submit that neither Quinlan nor Kamille alone or in combination teach all of the limitations of claim 14, and therefore, these references can not render claim 14 obvious.

Independent of the above, claims 15-25 depend directly and indirectly from claim 14 and should be patentable for at least the same reasons as claim 14. Claim 25 has been cancelled, so the rejection of claim 25 is moot. Claim 33 depends from claim 26 and should be patentable for at least the same reasons as claim 26.

Separately and independently, Applicants respectfully submit that Quinlan and Kamille do not render claim 24 obvious. Claim 24 recites a winning lottery ticket where a combination of winning game pieces match a

combination of revealed playing game pieces in the playing panel so that at least three of the revealed pieces adjoin horizontally, vertically or diagonally. Kamille discloses a probability game where winning is determined through the player made choices. Kamille Col. 3:59-67. In Kamille, a player's choice of play area determines whether a prize is awarded or whether the prize is forfeit. In Kamille, the spatial considerations of the revealed play areas do not determine a winning ticket. Therefore, Applicants respectfully submit that the references can not render claim 24 obvious because Quinlan and Kamille, alone or in combination, do not teach or suggest a winning lottery ticket where a combination of winning game pieces match a combination of revealed playing game pieces in the playing panel so that at least three of the revealed pieces adjoin horizontally, vertically or diagonally.

VIII. Rejection of Claims 34-40 and 47-49 Under 35 U.S.C. §103(a) Over Quinlan in View of Goodson

Claims 34-40 and 47-49 stand rejected under 35 U.S.C. § 103(a) over Quinlan in light of Goodson. Several times Examiner refers to Roberts in rejecting claims 34-40 and 47-49. Applicants have responded by assuming that Goodson was the reference Examiner intended to cite. Applicants respectfully traverse the rejection for at least the following reasons.

Claim 34 recites:

34. (Currently Amended) A method for playing a game of chance comprising:
receiving a game ticket
. . . .
receiving a first drawing event designation,
wherein the first drawing event designation includes a designation of a subset of the plurality of panels to be used in game play;

receiving a selection of a plurality of winning game pieces after a participant has received a game ticket, wherein the selection of the winning game pieces is external to the game ticket.

Claim 49 has similar recitations.

As stated above, Quinlan does not teach or suggest receiving a selection of a plurality of winning game pieces after a participant has received a game ticket, wherein the selection of the winning game pieces is external to the game ticket. Neither does Goodson teach nor suggest receiving a selection of a plurality of winning game pieces after a participant has received a game ticket, wherein the selection of the winning game pieces is external to the game ticket. Goodson generally discloses announcing what game information on the ticket will constitute a win. Goodson Col. 4:23-28. In Goodson, all the information needed to determine a win is located internal to the ticket and is present before a participant has received a game ticket. Therefore, Applicants respectfully submit that Quinlan and Goodson, either alone or in combination, do not render independent claims 34 or 49 obvious.

Moreover, a *prima facie* claim of obviousness also requires some suggestion or motivation in the art to modify or combine the references. See M.P.E.P. § 2143. "If the proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion to make the proposed modification. " M.P.E.P. § 2143.01. Applicants respectfully submit that the Examiner's proposed modification would render Quinlan unsatisfactory for its intended purpose. One of Quinlan's intended purposes is to facilitate player interest. Quinlan discloses that having the players select the prize windows facilitates player interest. Quinlan Col. 4:61-Col.5:4. If Quinlan was modified by Goodson, as Examiner

suggests, to where the players were told which prize panels the players had to open, it would decrease player interest and excitement, thereby rendering Quinlan unsatisfactory for its intended purpose. Therefore, there is no suggestion to modify the references, and thus Quinlan and Kamille can not render independent claims 34 and 49 obvious.

Claims 35-40, 47, and 48 depend from claim 34 and should be patentable for at least the same reasons as claim 34.

IX. Rejection of Claim 46 Under 35 U.S.C. § 103(a) Over Roberts in View of Fults

Claim 46 stands rejected under 35 U.S.C. § 103(a) over Roberts in view of Fults. Applicants respectfully traverse this rejection for at least the following reasons.

As an initial matter, claim 46 depends indirectly from claim 34, therefore claim 46 should be patentable for at least the same reasons as claim 34.

Moreover, claim 46 also depends from claim 45 and therefore should be patentable for at least the same reasons as claim 45 listed above

X. Rejection of Claim 25 Under 35 U.S.C. § 103(a) Over Quinlan in View of Kamille and in Further View of Scrymgeour

The Examiner rejected claim 25 as being obvious over Quinlan in view of Kamille in further view of Scrymgeour. Claim 25 has been cancelled but claim 58 addresses similar subject matter. It is respectfully submitted that claim 58 is patentable for at least the following reasons.

As an initial matter, claim 58 depends from claim 14 and should be patentable for at least the same reasons as claim 14.

Claim 58 recites:

58. (New) The method of claim 14 further comprising:
 receiving a second drawing designation;
 after receiving the lottery ticket, receiving a second random selection of a plurality of winning game pieces, wherein the second random selection is external to the lottery ticket;
 determining if the lottery ticket is a winner based on the first random selection the plurality of game pieces;
 determining if the lottery ticket is a winner based on the second random selection of the plurality of game pieces; and
 receiving a prize if the lottery ticket is a winner.

Applicants respectfully submit that Examiner's proposed combination does not teach or suggest after receiving the lottery ticket, receiving a second random selection of a plurality of winning game pieces, wherein the second random selection is external to the lottery ticket. For all of the references, information internal to the game ticket determines the winning indicia. In Quinlan, both the advance contestant windows and the prize reward windows are pre-printed on the ticket. In Kamille, the revealed play areas pre-printed on the ticket determine the prize award or the prize forfeit. Scrymgeour discloses

playing "the lottery ticket by removing the scratch-off layer covering the lottery indicia on the front surface The user then consults the lottery information printed on the ticket to determine if the lottery ticket is a winner." See Scrymgeour Col. 4:37-45 (*emphasis added*). Therefore, Applicants respectfully submit that none of the references, either alone or in combination, teach or suggest each of the limitations recited in claim 25. Therefore Quinlan, Kamille and Scrymgeour do not render claim 25 obvious.

Moreover, absent a motivation to combine references, there is no *prima facie* case of obviousness. See M.P.E.P. § 2143.01. Applicants respectfully submit that the Examiner provided no motivation to combine the references and engaged in hindsight reconstruction, which can not be used to establish obviousness. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, Examiner's proposed combination can not render claim 25 obvious.

XI. Establishing Priority to U.S. Patent Application 09/794,266

Applicants note with appreciation that the Examiner acknowledged the statement of priority to application number 09/794,266 filed February 27, 2001.

XII. New Claims

New claims 50-65 recite features neither taught nor suggested by the cited art and do not add new matter. New claims 58-65 were discussed with and suggested by Examiner in the December 19, 2003 telephone interview. New claims 50, 51, 58 and 59 depend from claim 14 and should be patentable for at least the reasons mentioned above for claim 14. Claims 52, 60 and 61

depend from claim 26 and should be patentable for at least the reasons mentioned above for claim 26. Claims 53, 54, 62 and 63 depend from claim 34 and should be patentable for at least the reasons mentioned above for claim 34. Claims 54-57, 64 and 65 depend from claim 49 and should be patentable for at least the reasons mentioned above for claim 49.

XIII. Conclusion

In view of the foregoing, it is respectfully submitted that the present claims are in condition for allowance. Passage to issuance is, therefore, respectfully requested. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully Submitted,

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